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BOARD OF PATENT APPEALS AND INTERFERENCES

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In re patent application:

Appl. No. : 09/693,285 Confirmation No.: 8085
Applicant : Leon A. Pintsov
Filed : October 20, 2003
Art Unit : 3621
Examiner : Firmin Backer
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Mail Stop Appeal Brief - Patents
Commissioner for Patents
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Alexandria, VA 22313-1450

APPELLANT'S BRIEF ON APPEAL

Sir:

This is an appeal pursuant to 35 U.S.C. § 134 and 37 C.F.R. §§ 1.191 et seq. from the final rejection of claims 16-31 of the above-identified application mailed August 1, 2003. The fee for submitting this Brief is \$330.00 (37 C.F.R. § 1.17(c)). Payment of the fee is provided in a separate Transmittal submitted herewith. The Notice of Appeal was received by the U.S. Patent and Trademark Office on November 5, 2003. Enclosed with this original are two copies of this brief.

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I. Real Party in Interest

The real party in interest in this appeal is Pitney Bowes Inc., a Delaware corporation, the assignee of this application.

II. Related Appeals and Interferences

There are no related appeals or interferences that may have a bearing on the Board's decision in this appeal.

III. Status of Claims

Claims 23-36 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter.

Claims 23-36 stand rejected under 35 U.S.C. 102(a) as being anticipated by Pintsov (US Patent No. 5,586,036).

Claims 16-32 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Pintsov (US Patent No. 5,586,036) in view of USPS "3 Special Services" and PS Form 2865.

IV. Status of Amendments

There are no amendments to the claims filed subsequently to the final rejection of August 1, 2003. Therefore, the claims as set forth in Appendix A to this brief are those as set forth before the final rejection.

V. Summary of Invention

Appellant's invention relates to the distribution of a mailpiece within an international mailing system. In accordance with the present invention value-added services data associated with a mailpiece includes addressing information for a return receipt from an intended mailpiece recipient for services performed by a final handling postal authority but confirmation is communicated by a first postal authority to the original mailer. During the delivery process, the

value-added service performed by the final handling postal authority and the final handling postal authority captures the data related to the delivery. The final handling postal authority then transmits this information to the first handling postal authority, which then communicates the information to the original mailer. The invention is practiced such that the identity of the mailer is disclosed only to the original postal authority and not to subsequent handling postal authorities.

Claim 23 provides a method for providing value-added services requested by a mailer and relating to the handling of a mailpiece by a plurality of postal authorities. According to the method of claim 23, a mail item is received at a final handling post and scanned to obtain a digital image of the mail item and an identifier for an initial handling post. Also obtained is a digital image of a signature of a recipient of the mail item as confirmation of delivery of the mail item. The digital images of the signature and the mail item are merged and the merged digital images are transmitted to the initial handling post. Claims 24-26 depend on claim 23. Claim 27 depends on claim 26; claim 28 depends on claim 24; claim 29 depends on claim 28.

According to claim 24, delivery confirmation is transmitted from the initial handling post to a mailer of the mail item. Claim 25 provides that the step of obtaining the digital image of the signature of the recipient includes the steps of obtaining a physical signature on a form; and scanning the physical signature to obtain the digital image of the signature. According to claim 26, the step of transmitting the merged digital images to the initial handling post includes the steps of: retrieving an electronic address corresponding to the initial handling post; compressing the merged digital images to form a transfer file; digitally signing the transfer file; and transmitting the digitally signed transfer file to the initial handling post using the electronic address. Claim 27 provides that the electronic address is one of an e-mail address, a facsimile number and a telephone number. Claim 28 provides the step of transmitting delivery confirmation from the initial handling post to the mailer of the mail item includes the steps of retrieving an electronic address of the mailer; and sending an electronic message to the mailer confirming delivery of the mail item. Finally, claim 29 provides that the electronic address is one of an e-mail address, a facsimile number, a pager number and a telephone number.

Claim 30 provides another aspect of the present invention with a method for providing value-added services requested by a mailer and relating to the handling of a mailpiece by a

plurality of postal authorities. According to the method of claim 30, a transfer file representing confirmation of delivery of a mail item by a final handling post is received electronically at an initial handling post. The transfer file is parsed to retrieve digital images of the mail item and a signature of a recipient confirming delivery of the mail item and confirmation of delivery of the mail item is sent to the mailer. Claims 31-35 depend from claim 30. Claim 32 depends from claim 32.

According to claim 31, the transfer file is digitally signed by the final handling post and the digital signature of the transfer file is verified and the transfer file is rejected if the digital signature is not correct. According to claim 32, the confirmation of delivery is sent to a mailer electronic address, which is either an e-mail address, a facsimile number, a pager number or a telephone number. According to claim 33, the step of parsing the transfer file includes parsing from the transfer file a mailer electronic address, a unique identity of the mail item and a unique identity of the mailer. According to claim 34 the step of parsing the transfer file includes parsing from the transfer file a unique identity of the mail item and a unique identity of the mailer; and the step of sending to the mailer confirmation of delivery of the mail item includes determining a mailer electronic address from a look up table. According to claim 35, the step of sending to the mailer confirmation of delivery of the mail item includes the step of sending electronically digital images of the mail item and signature of the recipient. Finally, claim 36 provides that the digital images of the mail item and the signature of the recipient are digitally signed before being sent.

Claims 16-22 describe a system for implementing the process described in claims 23-36. Additional features of the invention are discussed below in the Argument section of this Brief.

VI. Issues

- A. Whether the subject matter defined in is statutory subject matter.
- B. Whether the subject matter defined in claims 23-36 is anticipated by Pintsov (US Patent No. 5,586,036).
- C. Whether the subject matter defined in claims 16-36 is obvious over Pintsov (US Patent No. 5,586,036) in view of USPS “3 Special Services” and PS Form 2865.

VII. Grouping of Claims

Claims 16-31 stand or fall together.

VIII. Argument

As Appellant discusses in detail below, the final rejections of claims 16-31 is devoid of any factual or legal premise that supports the position of unpatentability. It is respectfully submitted that the rejections do not even meet the threshold burden of presenting a prima facie case of unpatentability. For this reason alone, Appellant is entitled to grant of a patent. In re Oetiker, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

A. The subject matter defined by claims 23-36 is statutory subject matter.

Claims 23-36 stand rejected under 35 U.S.C. 101 as being directed to non-statutory subject matter. In paragraph 2 of the Office Action, the Examiner contends that the inventive concept in claims 23-36 only recite an abstract idea and that the recited steps do not apply, involve, use or advance the technological arts since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. The Examiner cites *In re Toma (CCPA 197 USPQ 852 (1978))* in support of his position. The Examiner further states that the “recited method produces a useful, concrete and tangible result” but that the claimed invention, as a whole, is “not within the technological arts”. Applicant respectfully disagrees with the Examiner’s characterization of the claims 23-36.

First, the Examiner incorrectly states that the present claims 23-36 only recite an abstract idea. The bolded text in the following sections identify several of the elements in the claims that are not abstract ideas. As previously stated, claim 23 provides a method for providing value-added services requested by a mailer and relating to the handling of a mailpiece by a plurality of postal authorities. **The mail item is received at a final handling post and scanned to obtain a digital image of the mail item and an identifier for an initial handling post. Also obtained is a digital image of a signature of a recipient of the mail item as confirmation of delivery of the mail item. The digital images of the signature and the mail item are merged and the merged digital images are transmitted to the initial handling post.** In claim 25, a physical

signature is obtained on a form; and is scanned to obtain the digital image of the signature. In claim 26, the step of transmitting the merged digital images to the initial handling post includes the steps of: **retrieving an electronic address corresponding to the initial handling post; compressing the merged digital images to form a transfer file; digitally signing the transfer file; and transmitting the digitally signed transfer file to the initial handling post using the electronic address.** Claim 27 provides that the electronic address is one of an **e-mail address, a facsimile number and a telephone number.** Claims 30-36 include similar non-abstract ideas.

Second, the Examiner states that the recited steps do not apply, involve, use or advance the technological arts “since all the steps can be performed in the mind of the user or by use of pencil and paper and no specific technology (e.g. computer, processor) is expressly recited in the body of the claims. The Examiner has not supported this statement with any further comment other than to cite *In re Toma*. The bolded text in the following text identifies several of the elements in the claims that cannot be performed in the mind of the user or by use of pencil and paper. One skilled in the art, and probably those not skilled in the art, would understand that a mail item received at a final handling post must use some form of scanner, such as a digital camera, when **scanning the mail item to obtain a digital image of the mail item or a digital image of a signature of the mail recipient.** Furthermore, those skilled in the art would understand that once these digital images have been obtained, that some type of processor, such as a computer, would be needed to **merge the digital images of the signature and the mail item,** and that some type of digital communications would be needed to **transmit the merged digital images to the initial handling post.** It appears to the Applicants that the Examiner believes that without specifically including a scanner or computer in the elements of claims 23-36, the claims steps can be performed in the mind of the user or by use of pencil and paper. As indicated above, this is not the case, nor is there a requirement to expressly recite in the body of the claims the technology used to implement the process. The Examiner appears to rely on *In re Toma* to require such a recitation. However, *In re Toma* neither directly nor indirectly requires such a recitation. The claims at issue in *In re Toma* concern a translation process that is performed entirely in a computer. In such a case, when a computer performs the entire process, it could be argued that all the steps can be performed in the mind of the user or by use of pencil

and paper. However, as set forth above, the present invention as described in claims 23-36 requires some form of scanning device to scan the mail item.

Finally, the Examiner cited *In re Toma* (CCPA 197 USPQ 852 (1978)) in support of his position that claimed invention in claims 23-36 is not within the technological arts. However, *In re Toma* actually reverses a “technological arts” rejection for claims that describe translating between natural languages in a computer. In the present case, the scanning images into a computer is enough to reverse the “technological arts” rejection.

Accordingly, the Examiner’s comments simply have no merit. It is submitted that claims 23-36 clearly set forth statutory subject matter. For at least the above reasons, Appellant respectfully submits that the final rejections as to claims 23-36 are in error and should be reversed.

B. The claims 23-36 are not anticipated by Pintsov ‘036.

Claims 23-36 stand rejected under 35 U.S.C. 102(a) as being anticipated by Pintsov ‘036. In paragraph 4 of the Office Action, the Examiner recites claims 23 and 30 and contends that claims 23 and 30 read “on figure 1, element 106 and 108 and also fig. 4” of Pintsov ‘036. Element 106 is a mailer’s unique identification number. Element 108 represents service data required by the mailer and a unique identification for the mailpiece. See col. 6, lines 36-39. Figure 1 is a mailpiece having encrypted information imprinted thereon in accordance with Pintsov ‘036 which is thereafter utilized by a carrier in generating billing information and utilized to provide additional verifications and information and services to a mailer. Figure 4 is a block diagram of a carrier processing system for the generation of billing records.

Applicant respectfully disagrees with the Examiner’s characterization of the claims 23-36. The present invention, in contrast to Pintsov ‘036, is directed to the distribution of a mailpiece by a plurality of postal authorities wherein value-added services data associated with a mailpiece includes addressing information for a return receipt from an intended mailpiece recipient for services performed by a final handling postal authority but confirmation is communicated by a first postal authority to the original mailer because the identity of the mailer is disclosed only to the original postal authority and not to subsequent handling postal authorities.

Contrary to the Examiner's comments, there is nothing in Pintsov '036 that discloses or suggests the following elements from independent claim 23:

- scanning the mail item to obtain a digital image of the mail item and an identifier for an initial handling post;
- obtaining a digital image of a signature of a recipient of the mail item as confirmation of delivery of the mail item;
- merging the digital images of the signature and the mail item; and
- transmitting the merged digital images to the initial handling post.

Contrary to the Examiner's comments, there is nothing in Pintsov '036 that discloses or suggests the following elements from independent claim 30:

- receiving electronically at an initial handling post a transfer file representing confirmation of delivery of a mail item by a final handling post;
- parsing the transfer file to retrieve digital images of the mail item and a signature of a recipient confirming delivery of the mail item; and
- sending to the mailer confirmation of delivery of the mail item.

Pintsov '036 describes a system and method in which the mailpiece is scanned to obtain the mailer's identification (element 106), an encrypted hash code and addressee data. There is no teaching or suggestion of scanning the mail item to obtain a digital image of the mail item and an identifier for an initial handling post.

Furthermore, the present invention provides for **obtaining a digital image of a physical signature by the mail recipient**. Pintsov '036, on the other hand, describes a system and method that requires digital signatures representing digitally signed messages – not obtaining digital images physical signatures of recipients. See, for example, Pintsov '036 at col. 5, lines 8-13:

the mail recipient can digitally sign by encrypting a message containing unique sender identification and unique mail piece identification with his own private key. The mail sender upon receiving the confirmation can decrypt the mail receiver signature with the mail recipient public key.

As well known by those skilled in the art, a digital signature, which is used for authentication, cannot be confused with a digital image of a physical signature. Thus, Pintsov '036 does not teach or suggest the present invention as set forth in claims 23-36. In fact, the disclosure in Pintsov '036 is in no way related to the present invention as claimed, i.e., a system and method for preventing subsequent postal authorities from having access to a mailer's electronic address, whereby the subsequent postal authority would be able to communicate directly with the mailer

and bypass the originating postal authority in the future. Pintsov '036 does not teach or suggest anything related to multiple postal authorities, or the use of electronic mail to provide value added service confirmation.

For at least the above reasons, Appellant respectfully submits that the final rejections as to claims 23 and 30 are in error and should be reversed. Claims 24-29 and 31-36 are dependent upon claims 23 and 30 respectively and therefore the final rejection with respect to these claims should also be reversed.

C. The claims 16-36 are patentable over Pintsov (US Patent No. 5,586,036) in view of USPS "3 Special Services" and PS Form 2865.

Claims 16-36 stand rejected under 35 U.S.C. 103 (a) as being unpatentable over Pintsov (US Patent No. 5,586,036) in view of USPS "3 Special Services" and PS Form 2865. In paragraph 6 of the Office Action, the Examiner specifically rejects claim 16 but also comments on claims 17-36 as being rejected under 103(a) as well.

Regarding claim 16, the Examiner contends that

Pintsov teaches a postage payment system with security for sensitive mailer data and enhanced carrier functionality such that Applicant's step of combining a set of value-added services into a machine readable mark on a mailpiece reads on figure 1, element 108, Applicant's step of reading said mark at a second handling postal authority reads on the destination country receiving the mailpiece and interpreting the mark, Applicant's step of performing the valued added service reads on the destination country performing the value-added service, Applicant's step of sending a message to said first handling postal authority reads on the destination country (second handling postal authority) sending completed form 2865 to the first handling postal authority (USPS) and Applicant's step of determining an original mailer electronic address at said first handling authority reads on element 106.

The Examiner acknowledges that Pintsov '036 does not teach the use of his system for international purposes but relies on PS Form 2865 for evidence that the value added service of return receipt between the USPS and other countries has been performed since 1985. The Examiner also states that Pintsov discloses creating a machine-readable mark including a mailer identification code and value-added service data and that that USPS "3 Special Services" indicates the procedure the other country follows with regard to the value-added service of return receipt for international mailpieces. The Examiner concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teachings of Pintsov

'036 to include international handling of value added service requests along with its handling of domestic mail as it will widen marketability and profits of the Pintsov '036 system and streamline the handling of value added services regardless of whether the mail is domestic or international.

Applicant respectfully disagrees with the Examiner's characterization of the claims 16-36. The present invention, in contrast to Pintsov '036, is directed to the distribution of a mailpiece by a plurality of postal authorities wherein value-added services data associated with a mailpiece includes addressing information for a return receipt from an intended mailpiece recipient for services performed by a final handling postal authority but confirmation is communicated by a first postal authority to the original mailer because the identity of the mailer is disclosed only to the original postal authority and not to subsequent handling postal authorities.

It appears that the Examiner does not understand the present invention. In the rejection of claim 16, the Examiner does not discuss, nor does Pintsov '036, USPS "3 Special Services" or PS Form 2865, alone or in combination, disclose the following elements of claim 16:

- a) a first database of mailer electronic addresses indexed by mailer identification codes;
- b) means for creating at a first postal authority a mail item file corresponding to the mailpiece; said mail item file including said mailer identification code and said value-added service request; or
- g) means for communicating said performance of said value-added service to said first postal authority using said first postal authority address, wherein said first postal authority determines a mailer electronic address using a mailer identification code associated with the mailpiece and communicates performance of said value-added service to the mailer using the mailer electronic address.

Furthermore, as set forth above with regard to the 102(b) rejection, Pintsov '036 does not teach or suggest the system that provides for a distribution of a mailpiece by a plurality of postal authorities, wherein value-added services data associated with a mailpiece includes addressing information for a return receipt from an intended mailpiece recipient for services performed by a final handling postal authority, but confirmation is communicated by a first postal authority to

the original mailer because the identity of the mailer is disclosed only to the first postal authority and not to subsequent handling postal authorities. Thus, the combination of Pintsov '036 with USPS "3 Special Services" and with PS Form 2865 does not disclose, teach or suggest the limitations of claim 16.

Concerning the rejection of independent claims 23 and 30, the Examiner contends, at the end of paragraph 6 of the Office Action, that they are rejected because they disclose the same inventive concept as claims 16. Thus, for the same reasons as set forth above concerning the 102(b) rejections, Applicants disagree with these rejections.

For at least the above reasons, Appellant respectfully submits that the final rejections as to claims 16, 23 and 30 are in error and should be reversed. Claims 17-22, 24-29 and 31-36 are dependent upon claims 16, 23 and 30 respectively and therefore the final rejection with respect to these claims should also be reversed.

IX. Conclusion

In Conclusion, Appellant respectfully submits that the final rejections of claims 16-31 is in error for at least the reasons given above and should, therefore, be reversed.

Respectfully submitted,



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APPENDIX A

16. A system for providing value-added services relating to the distribution of a mailpiece within an international mailing system comprising:

- c) a first database of mailer electronic addresses indexed by mailer identification codes;
- d) a second database of postal authority addresses indexed by postal authority identification codes;
- e) a means for incorporating a request for a value-added service and a mailer identification code on a mailpiece;
- f) means for creating at a first postal authority a mail item file corresponding to the mailpiece; said mail item file including said mailer identification code and said value-added service request;
- e) means for determining, at a second postal authority, said first postal authority address; and
- f) means for performing by said second postal authority said value-added service;
- g) means for communicating said performance of said value-added service to said first postal authority using said first postal authority address, wherein said first postal authority determines a mailer electronic address using a mailer identification code associated with the mailpiece and communicates performance of said value-added service to the mailer using the mailer electronic address.

17. The system as claimed in claim 16 wherein said mailer identification code is encrypted.

18. The system as claimed in claim 16 wherein said first database includes said mailer e-mail address.

19. The system as claimed in claim 16 wherein said second database includes said postal authority e-mail address.

20. The system as claimed in claim 16 wherein said value-added service request is a confirming electronic message.
21. The system as claimed in claim 17 wherein said set of data relating to value-added service request includes a facsimile number.
22. The system as claimed in claim 17 wherein said value-added service request is an electronic confirmation of receipt.
23. A method for providing value-added services requested by a mailer and relating to the handling of a mailpiece by a plurality of postal authorities, the method comprising:
- receiving a mail item at a final handling post;
 - scanning the mail item to obtain a digital image of the mail item and an identifier for an initial handling post;
 - obtaining a digital image of a signature of a recipient of the mail item as confirmation of delivery of the mail item;
 - merging the digital images of the signature and the mail item; and
 - transmitting the merged digital images to the initial handling post.
24. The method of claim 23 comprising the further step of:
- transmitting delivery confirmation from the initial handling post to a mailer of the mail item.
25. The method of claim 23 wherein the step of obtaining the digital image of the signature of the recipient includes the steps of:
- obtaining a physical signature on a form; and
 - scanning the physical signature to obtain the digital image of the signature.
26. The method of claim 23 wherein the step of transmitting the merged digital images to the initial handling post includes the steps of:
- retrieving an electronic address corresponding to the initial handling post;

compressing the merged digital images to form a transfer file;
digitally signing the transfer file; and
transmitting the digitally signed transfer file to the initial handling post using the
electronic address.

27. The method of claim 26 wherein the electronic address is one of an e-mail address, a facsimile number and a telephone number.

28. The method of claim 24 wherein the step of transmitting delivery confirmation from the initial handling post to the mailer of the mail item includes the steps of:

retrieving an electronic address of the mailer; and
sending an electronic message to the mailer confirming delivery of the mail item.

29. The method of claim 28 wherein the electronic address is one of an e-mail address, a facsimile number, a pager number and a telephone number.

30. A method for providing value-added services requested by a mailer and relating to the handling of a mailpiece by a plurality of postal authorities, the method comprising:

receiving electronically at an initial handling post a transfer file representing
confirmation of delivery of a mail item by a final handling post;
parsing the transfer file to retrieve digital images of the mail item and a signature of a
recipient confirming delivery of the mail item; and
sending to the mailer confirmation of delivery of the mail item.

31. The method of claim 30 wherein the transfer file is digitally signed by the final handling post, the method comprising the further steps of:

verifying the digital signature of the transfer file; and
rejecting the transfer file if the digital signature is not correct.

32. The method of claim 30 wherein the confirmation of delivery is sent to a mailer electronic address, the mailer electronic address being one of an e-mail address, a facsimile number, a pager number and a telephone number.
33. The method of claim 30 wherein the step of parsing the transfer file includes parsing from the transfer file a mailer electronic address, a unique identity of the mail item and a unique identity of the mailer.
34. The method of claim 30 wherein the step of parsing the transfer file includes parsing from the transfer file a unique identity of the mail item and a unique identity of the mailer; and the step of sending to the mailer confirmation of delivery of the mail item includes determining a mailer electronic address from a look up table.
35. The method of claim 30 wherein the step of sending to the mailer confirmation of delivery of the mail item includes the step of:
 sending electronically digital images of the mail item and signature of the recipient.
36. The method of claim 32 wherein digital images of the mail item and the signature of the recipient are digitally signed before being sent.